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APPLICATION NO.	FILING DATE.	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,194	10/24/2000	Gary Anthony Jubb	M8540/248465	1647

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EXAMINER

GROUP, KARL E

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/21/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/695,194

Applicant(s)
Jubb et al

Examiner
Karl Group

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 26, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1755

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-26-02 has been entered.

2. The abstract of the disclosure is objected to because it does not clearly describe the claimed invention. Correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper content of an Abstract of the Disclosure. In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

4. A substitute specification without the claims is required pursuant to 37 CFR 1.125(a) because the specification does not maintain proper margins and the tables are not legible.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute

Art Unit: 1755

specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 14-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14, the limitation "repeated exposures to temperatures exceeding 900 °C" is considered new matter. The term "repeated" suggests a temperature cycling which lacks support in figure 3. Also greater than 900°C is not supported, i.e. 1500°C. The original claims do not provide support for cycling temperatures at 900°C. It is agreed that tables 7 and 8 provide cycling temperatures at 1000°C and 1100°C however greater than 900°C encompasses temperatures such as 1500°C which is not supported. Furthermore, the preliminary amendment filed 10-24-00 cannot provide support for an amendment. The preliminary amendment is not considered to provide support as if it is part of the filed disclosure. The preliminary amendment is NOT considered an original claim. Neither page 4 or page 6 provides support for cycling.

Art Unit: 1755

Claim 23, figure 3 lacks support for 3.5 hours or greater. This includes lengths of exposure such as 10 hours which is not contemplated. Also exceeding 900°C is new matter since this includes temperatures not contemplated such as 1500°C. Furthermore, the specification and figures are tests of the fibers not disposed on an article. It is requested that applicants point to the disclosure where the language of claim 23 “insulating an article in applications requiring resistance for about 3.5 hours or more”. Emphasis on ARTICLE. The specification deals only with subjecting the fibers. Also where is support for times greater than 24 hours?

7. Claims 14-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14, the limitation “repeated exposures to temperatures exceeding 900 °C” is considered new matter. The term “repeated” suggests a temperature cycling which lacks support in figure 3. Also greater than 900°C is not supported, i.e. 1500°C.

Claim 23, figure 3 lacks support for 3.5 hours or greater. This includes lengths of exposure such as 10 hours which is not contemplated. Also exceeding 900°C is new matter since this includes temperatures not contemplated such as 1500°C.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1755

9. Claims 14-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Olds et al, US 5,322,699, Olds et al WO 87/05007 and Karppinen et al, each taken alone, for reasons of record.

Applicants argue that the prior art references fail to teach use of the claimed fibers at temperatures greater than 900°C as set forth in the preambles of claims 14 and 23. It is noted that applicants make reference to a declaration in a parent application. This declaration is not made of record in this application and cannot be incorporated by reference.

This is not persuasive in overcoming the rejection because the claims fail to set forth an active process step requiring exposure at 900°C or greater. The claim limitations are considered intended uses which do not further limit the claims. The only active process step set forth in the instant claims is “disposing on, in, near or around the article” which is clearly taught by the references. If the articles are intended to be insulated at the temperatures recited in the claims it is not understood why the claims do not include an active process step requiring subjecting the articles to the temperatures. Further more the “requiring resistance” fails to quantify the resistance of the article once the thermal insulation is disposed. Further more it cannot be seen how materials of the same composition may have more heat insulation properties than the other. The fiber compositions of the prior art fall squarely within the claimed ranges. Products of identical chemical composition can not have mutually exclusive properties. In re Spada, 15 USPQ2d 1655,1658 (Fed. Circ. 1990). It is further argued that compositions are not being

Art Unit: 1755

claimed but new methods of use. It should be clear that the only active process step set forth in the claims is the step of disposing.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Group whose telephone number is (703)308-3821. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703)308-3823. The fax phone number for this Group is (703)872-9310, for any non-final amendment or communication, and (703)872-9311 for any after-final amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.



**KARL GROUP
PRIMARY EXAMINER
ART UNIT 1755**

Keg
May 21, 2002
